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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,426	06/24/2003	Phillip Clark	MCA-640	9664

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MILLIPORE CORPORATION
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EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/602,426

Applicant(s)

CLARK ET AL.

Examiner

Dwayne K. Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-22 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 recites the limitation of “the base comprising an outer peripheral flange and a side wall which together form a peripheral groove and wherein a portion of the flange contacts a slot formed in the collar”. This embodiment is shown in Figures 7 and 8 and described in Paragraph [0040]. Figure 8, however, shows the outer peripheral flange (4) in contact with **the skirt (15) of the collar and not contacting the slot (6') of the collar** as required by the claim. The wiper portion (51) of the gasket (5') extends into the slot (6') of the collar – but the flange does not. Therefore, it is unclear how the cited limitation may be met.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5-8, 11, 12 and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Moring et al. (6,159,368). This rejection was applied to claims 1-3, 5-6 and 11-21 in the previous Office Action (mailed 6/15/06). It remains in effect for claims 1-3, 5-8, 11, 12 and 16-21. Please see Response to Arguments below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moring et al. (6,159,368) in view of Vestal (5,498,545). This rejection was made in the previous Office Action (mailed 6/15/06). It remains in effect. Please see Response to Arguments below.

Response to Arguments

6. The Examiner has lifted the rejection of claims 13-15 under U.S.C 102(b) as anticipated by Moring in response to Applicant's amending of claim 13 in the response submitted 11/14/06.

7. Applicant has also amended claim 1 to recite a collection plate "which contacts the first processing device" and then argued that Moring does not teach this feature (Page 7, lines 1-7 of submitted Arguments). Applicant also notes the Examiner's reference to element (10) in a previous Office Action as a "first sample processing device". The Examiner respectfully disagrees that Moring does not teach this feature and directs Applicant to column 11, lines 26-42 of Moring:

(3) FIGS. 1-3 show, in perspective, exploded and partial side-sectional views, respectively, an embodiment of a multi-well microfiltration apparatus constructed in accordance with the present invention. In the assembly stage of manufacture, a filter sheet or membrane, indicated in FIG. 2 by the reference numeral 8, is located between a column tray, or plate, 10 having an array of open-bottom mini-columns, such as 12, and a drip-director tray, or plate, 14 having an array of drip directors, such as 16, corresponding to the mini-columns. **Upon registering and mating mini-columns 12 with drip directors 16, an array of microfiltration wells are formed,** denoted generally in FIG. 3 by the reference numeral 18, each having a discrete filter element or medium (e.g., a plug, disc, or the like), such as 8a and 8b, positioned therein. The inner walls of each mated mini-column/drip-director pair bound a flow pathway which extends downward through the well 18.

Applicant has broadly claimed a "first sample processing device". The Examiner submits that the combined element (Figure 4) formed by the mating of the column plate (10) to the drip-director plate (14) is a "first sample processing device". This combined device contacts the collection plate (24).

8. Applicant has further argued that Moring does not anticipate the method of claims 16-21. In particular, Applicant has argued that Moring does not teach a device that does not have relative movement of the sample processing unit upon application of

a vacuum (page 7, lines 23-31). This is due to the presence of gaskets (42, 48). The Examiner respectfully disagrees and directs Applicant to Figure 7 and column 24, lines 10-35. In this passage, Moring discloses the use of a vertical positioning mechanism. The mechanism comprises springs (92) and fluid cylinders (94) that engage the handles (96) of the support frame (38). The vertical positioning mechanism is operable in several arrangements **including a down or seal position**. The Examiner submits that in the down or seal position, the gaskets are already compressed by mechanical force and therefore the application of vacuum would not affect them and move the sample processing unit. The Examiner also directs Applicant to column 26 for a recitation of method steps including providing the device elements, assembling them, applying the downward force, and applying vacuum.

9. Applicant has also argued that one would not be motivated to combine Moring with Vestal. Moring teaches the collection of processed samples in a well plate. Moring does not teach analysis of the collected samples. Vestal teaches the analysis of samples by MALDI using a well plate having specific features for MALDI. The Examiner submits that one would be motivated to combine the plate from Vestal with the device of Moring in order to be able to analyze the contents of the wells simply by transferring the plate to a MALDI apparatus – as in Vestal. This does not require the hindsight suggested by Applicant (page 8, lines 23-24), but instead a recognition that both Moring and Vestal use well plates – Moring to collect samples, Vestal to analyze them – and providing a plate that can be used to both collect and analyze would save processing

time. One of ordinary skill in the art would recognize that saving processing time would result in more samples analyzed.

Allowable Subject Matter

10. Claim 23 is allowed. The following is a statement of reasons for the indication of allowable subject matter: Claim 23 recites a manifold assembly comprised of a collar, base, unitary seal, first sample processing device and a second device stacked below the first sample processing device. The first and second devices form an integral stacked unit positioned between said collar and said base. The unitary seal seals between the collar and base AND between said first sample processing device and the collar. The Examiner did not find prior art that teaches or suggests this combination of feature that includes the unitary seal.

11. Claim 10 remains objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

Art Unit: 1743

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
January 4, 2007


Jill Warden
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